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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,762	01/21/2000	Tetsuo Watanabe	3190-004	4870

7590 05/27/2003

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EXAMINER	
MULCAHY, PETER D	
ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-B

Office Action Summary	Application No.	Applicant(s)	
	09/488,762	WATANABE ET AL.	
	Examiner	Art Unit	
	Peter D. Mulcahy	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *16* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Applicants' Request for Reconsideration, Request for Reinstatement of Appeal and Supplemental Information Disclosure Statements have all been considered and are of record.

It is acknowledged that applicants have requested the case go to appeal, however the case is not in condition for appeal at the present time. It should be further noted that the Request for Reinstatement of the Appeal which was accompanied by a Supplemental Appeal Brief was not compliant. Applicants failed to file the required three copies of the Appeal Brief.

Applicants' filing of the Information Disclosure Statement has necessitated the following new grounds of rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 102(b) or (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 02-001284, Haffner et al. (U.S. Patent No. 6,096,014) or Wehner et al. (U.S. Patent No. 6,063,981).

Each of the cited documents shows medical adhesive materials wherein a base material is formed from a thermoplastic resin and having fillers included therein which fall within the scope of applicants' instantly claimed silicic acid compound. See the constitution paragraph of the Japanese Abstract as well as Haffner at columns 5 and 6 and Wehner at columns 4 and 5. In view of this disclosure, applicants' claims are not novel.

With respect to the stress relaxation ratio property as instantly claimed, it is considered to be either anticipated or rendered obvious from the compositions disclosed in the prior art. The Examiner maintains that the prior art shows each of applicants' claimed ingredients and teaches that they be used in

combination with one another as claimed. It would be reasonable for one of ordinary skill in the art to presume that the prior art possesses properties which either anticipate or render obvious the instantly claimed properties given the fact that the compositions are the same.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kobylivker et al. (U.S. Patent No. 6,002,064).

The rejection as set forth under 35 U.S.C. § 102/103 in Paper No. 14 is deemed proper and is herein repeated.

Applicants' arguments have been fully considered but have been deemed to be not persuasive.

Applicants extensively argue that the applications of the Kobylivker et al. patent are simply types of medical apparel. Applicants argue that the medical apparel does not fall within the scope of the instantly claimed invention. This is not persuasive. Applicants' claims read on a medical sheet. A surgical gown is considered to be a medical sheet. The fact that the surgical gown is somehow fashioned to fit around a person does not negate the fact that it is a medical sheet. As being a medical sheet, it is seen to fall within the scope of the claims. Applicants extensively argue limitations which are not in the claims but are discussed in the specification. The Examiner does not find the specification to limit the claims so as to bring the

instantly claimed invention outside of the metes and bounds of the Kobylivker et al. patent. As such, the claims remain unpatentable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

The fax telephone number for this group is (703) 305-3599.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc
May 16, 2003

PETER D. MULCAHY
PRIMARY EXAMINER